11/07/01

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Paper No. 30
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

Trademark Trial and Appeal Board

_____

Avon Products, Inc.

v.

Something Old, Something New, Inc.

_____

Cancellation No. 28,715

_____

William R. Golden, Jr. and Paul W. Garrity of Kelley Drye & Warren LLP for Avon Products, Inc.

Randy M. Friedberg of Olshan Grundman Frome Rosenzweig & Wolosky LLP for Something Old, Something New, Inc.[1]

_____

Before Simms, Wendel and Drost, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Avon Products, Inc. has filed a petition to cancel Registration No. 2,199,074 for the mark BIRTHSTONE for "perfumes and perfume toilet soaps."[2]

---

[1] Although respondent's attorney had filed a request to withdraw as counsel prior to the filing of respondent's brief, the Board denied the original request and allowed counsel time to perfect the request so as to comply with the requirements of Trademark Rules 2.19(b) and 10.40. Counsel failed to avail himself of this opportunity and accordingly remains counsel of record.

[2] Registration No. 2,199,074, issued October 20, 1998. Certificate of correction issued April 6, 1999, limiting goods

In the petition to cancel, petitioner alleges, inter alia, that petitioner has at least since 1992 used the designation "birthstone" with a wide array of products and that other entities have similarly referred to products incorporating jewels, or representations of jewels, for each month of the year by using the descriptive term "birthstone"; that petitioner in 1998 introduced PERSONALLY YOURS birthstone cologne; that the registration at issue was fraudulently obtained by respondent in that respondent had made no use in commerce of the mark on any of the goods at the time the Statement of Use was filed; and that the mark BIRTHSTONE was generic or merely descriptive of respondent's goods at the time the registration issued.

Respondent, in its answer, has denied the salient allegations of the petition to cancel.

The Record

The record consists of the pleadings; the registration file; petitioner's trial testimony depositions, with accompanying exhibits, of Carol Trapano, an independent sales representative of Avon; Marie Macchia, a legal assistant for petitioner's counsel; Norma Cybul, President of respondent; Laurie

---

to "perfumes and perfume toilet soaps" and amending claimed

Cybul, Vice-President of respondent; portions of the discovery deposition of Laurie Cybul and certain interrogatory responses, made of record by petitioner's first notice of reliance; exhibits introduced during the testimony of Carol Trapano and Maria Macchia and reintroduced by petitioner's second notice of reliance; respondent's trial testimony depositions, with accompanying exhibits, of Laurie Cybul;[3] Alyssa Ollins, a public relations specialist for Avon, and Howard Biegel, directory editor for Beauty Fashion, Inc.;[4] various

---

dates of first use from February 11, 1998 to August 10, 1997.

[3] Petitioner's objections to certain portions of the testimony of Laurie Cybul as being non-responsive or hearsay have been taken under consideration in determining the probative weight to be given to this testimony.

[4] Petitioner has requested that the depositions of Mr. Biegel and Ms. Ollins be stricken in that the transcripts were not timely filed with the Board, but rather were attempted to be introduced by respondent's brief. The request is denied.

Although the transcripts of these depositions were not filed with the Board until after the filing of petitioner's main brief, but prior to the filing of respondent's brief, it is clear that petitioner was fully aware of these depositions taken during respondent's testimony period, since petitioner's counsel was present and participated in the depositions. (We note that petitioner has not objected to the testimony taken of Laurie Cybul in the same time period, the transcript of which was also late filed with the Board). Pursuant to Trademark Rule 2.125(a), if the transcript with exhibits is not served on the adverse party within thirty days of the taking of the deposition, the adverse party has remedy by means of a motion to the Board to reset the party's testimony and/or briefing periods, as may be appropriate. Petitioner did not do so here, and thus we assume petitioner had been served with the transcripts. Even if not served, petitioner waived its remedy by failing to file a motion with the Board. Under Rule 2.125(a) only if the Board orders the deposing party to serve a copy of the transcript on the adverse party and the deposing party fails

publications and copies of third-party registrations made of record by means of respondent's notice of reliance;[5] and petitioner's rebuttal trial testimony deposition of David Trugerman, the owner of Vivaldi Boutique.

Both petitioner and respondent have filed briefs on the case but an oral hearing was not requested.

The Registration

Respondent filed its intent-to-use application for the mark BIRTHSTONE on April 11, 1997. The goods as identified in the application covered a wide variety of cosmetics, perfume items and other toiletries. The declaration was signed by Laurie Cybul, as Vice-President

---

to do so does the Board have the option of striking the deposition. Such is clearly not the case here. The depositions stand of record.

[5] Petitioner's objections to Exhibits 1-5 of the notice of reliance are well taken. All are pages from Avon product catalogs which we do not find to fall within the category of printed publications of general circulation as encompassed by Trademark Rule 2.122(e), absent any evidence on the part of respondent of widespread general circulation of these catalogs. See Wagner Electric Corp. v. Raygo Wagner, Inc., 192 USPQ 33 (TTAB 1976). However, at least one of these catalog excerpts was introduced during the testimony of Laurie Cybul and as such has been considered. (See Respondent's Exhibit 21).

Petitioner's objection to Exhibit 26 is not well taken inasmuch as the pages from this trade magazine were also introduced into evidence during the testimony of Laurie Cybul. (See Respondent's Exhibit 20).

Petitioner's objection to Exhibit 28 is also not well taken. The errata sheet, which consists of a portion of the discovery deposition which was not relied upon by petitioner may be introduced by respondent by means of a notice of reliance. See Trademark Rule 2.120(j)(4).

Petitioner's objections to Exhibits 23-25 and 27 are well taken and these exhibits have not been considered.

of the applicant. A Notice of Allowance was issued February 3, 1998. Respondent subsequently filed a Statement of Use on June 18, 1998, claiming February 11, 1998 as the date of first use and the date of first use in commerce. In this statement the identification of goods was narrowed to the following: perfumes, colognes, eau de perfums, eau de toilettes, toilet waters and essential oils for personal use; sachets; toiletries, namely, perfume toilet soaps, body lotions and creams, body shampoos, hair shampoos and hair dressing lotions and gels, bath gels, bath oils, milk baths, bath salts, bath bubbles, bath fizzes, body powders and talcum powder, bath softening liquids, skin and body deodorants and anti-perspirants; and nail enamels. The declaration in the Statement of Use was also signed by Laurie Cybul. After deletion of the item “bath fizzes” by Examiner’s Amendment, the application issued as a registration on October 20, 1998.

The next paper in the registration file is a Request for Correction filed by Laurie Cybul on behalf of respondent under Trademark Rule 2.175 on November 25, 1998. Respondent states that the goods were incorrectly identified in the registration and requests that the registration be corrected to reflect that the mark

BIRTHSTONE had only been used with "perfumes and soaps." Respondent further states that the dates of first use are incorrect and should read that the mark was first used in connection with perfumes on August 10, 1997 and with soaps on February 11, 1998. After a telephone communication, which appears to have taken place between the Office and respondent's counsel, the identification of goods was amended to "perfumes and perfume toilet soaps" and the date of first use to be listed for the single class of goods was designated as the August 10, 1997 date.[6] On April 6, 1999, the certificate of correction issued, showing these changes to the registration.

Laurie Cybul testified that upon receiving the formal registration certificate in the mail, she immediately realized that there had been a mistake by the inclusion of so many products in the registration and contacted the law firm which had handled the application to rectify the matter. While acknowledging that she had

[6] Under 37 CFR 2.88(c) if more than one item of goods is specified in the Statement of Use, the dates of use required to be set forth need only be for one of the items specified in each class, provided the particular item to which the dates apply is designated. See also TMEP 904.09. Thus, no consideration has been given to petitioner's claim that respondent falsely represented that its mark had been used with both perfumes and soaps on August 10, 1997 by allowing the designation of a single date in the certificate of correction.

signed the original application with the broad identification of goods, after having been advised to keep it broad at that point, Ms. Cybul testified that she insisted that a correction be made in the registration. The Request for Correction was filed soon thereafter by the law firm.

At about the same time, respondent, citing its ownership of the registration, sent a cease and desist letter on November 5, 1998 to petitioner with respect to petitioner's offering for sale a fragrance called "Personally Yours Birthstone Cologne." (Pet. Exhibit 20). Although unsubstantiated by any evidence of record, petitioner claims that after receiving this letter it made an investigation into respondent's claim of use of its mark and subsequently communicated with respondent's counsel to the effect that it had learned that respondent had no BIRTHSTONE products in production. The petition to cancel was filed February 12, 1999.

Activities of Respondent

Norma and Laurie Cybul, mother and daughter, are the two full-time employees of respondent, which presently operates as a wholesale company specializing in jewelry, toiletries and the like. Sometime in 1996, the two women

come up with the concept of a fragrance “that would represent the qualities that would be in ...birthstones.” (Resp. L. Cybul deposition p. 18). Respondent not being in the manufacturing business, the Cybuls had bottles especially made up for them and shipped to them by a company named BTC, together with the fragrance which they had selected to be used therein, all prior to August 1997. A set of twelve bottles, each having in the cap a different colored imitation stone to correlate with the separate birthstones, was filled with fragrance by the women and taken for display, fully labeled with the BIRTHSTONE mark, at their booth at the New York International Gift Fair at the Jacob Javits Center in New York City on August 10, 1997. It was estimated that there were at least 45,000 attendees at this show. Although promoting their perfumes by “spritzing” potential customers, the Cybuls encountered price resistance to the product and did not obtain any orders for their perfume, nor were they able to make any sales, although they were willing to sell the actual bottles by the last day. While cards were left by several interested persons, no sales were obtained on follow-up with these persons. There is no evidence of record of any actual sale of the BIRTHSTONE perfume until the fall of 1999.

It was at the Javits show that the Cybuls talked with a representative of the Bradford Soap Company and firmed up the idea of using the BIRTHSTONE mark on a soap product as well. The soap as it has evolved comes as a two-tone colored glycerin soap which coordinates with an acrylic gem on top of the soap indicating the birthstone for a particular month. Although test market batches of soap were obtained before this time, the first quantity order for soap from the Bradford Company was not until July of 2000.

Laurie Cybul testified, however, to the first sale of a set of three bars of soap on February 11, 1998 to David Trugerman, the owner of Vivaldi Boutique. She stated that Mr. Trugerman ordered the soap and paid $5.50 for the same, and an invoice to this effect was made of record (Pet. Exhibit 22). There is no record of any receipt of payment.

Mr. Trugerman, in rebuttal, testified that a sample of the soap had been given to him by the Cybuls to consider for purposes of ordering it to use as a gift for his customers, but that he did not pay for the soap and he did not think the soap was appropriate and discarded it.

The Fraud Issue

Petitioner maintains that the involved registration should be cancelled because it was obtained by respondent as a result of respondent's knowing and willful false statements to the Patent and Trademark Office (PTO) that the mark had been used in commerce. Respondent's fraudulent acts or statements are argued to include not only the declaration made in the Statement of Use as to the use of the mark in commerce in connection with the goods as identified therein, as well as the subsequent representation in the Examiner's Amendment of use of the mark in commerce with all of the goods except "bath fizzies," but also the representation in the Request for Correction that the mark had been used in commerce with perfumes and soaps as of August 10, 1997 and February 11, 1998, respectively.

Thus, the allegedly fraudulent statements are claimed to encompass not only respondent's representations as to use of the mark on goods of the scope identified in the Statement of Use, and the amendment made thereafter, but also as to use of the mark as of the dates of use set forth in both the Statement of Use and the Request for Correction.

Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material

representations of fact in connection with his application. Torres v. Cantine Torresella S.r.l., 808 F2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). In making our analysis of respondent's actions, we are governed by the following principles of what constitutes fraud:

> Fraud implies some intentional deceitful practice or act designed to obtain something to which the person practicing such deceit would not otherwise be entitled. Specifically, it involves a willful withholding from the Patent and Trademark Office by an applicant or registrant of material information or facts which, if disclosed to the Office, would have resulted in the disallowance of the registration sought or to be maintained. Intent to deceive must be "willful." If it can be shown that the statement was a "false misrepresentation" occasioned by an "honest" misunderstanding, inadvertence, negligent omission or the like rather than one made with a willful intent to deceive, fraud will not be found. Fraud, moreover, will not lie if it can be proven that the statement, though false, was made with a reasonable and honest belief that it was true or that the false statement is not material to the issuance or maintenance of the registration. It thus appears that the very nature of the charge of fraud requires that it be proven "to the hilt" with clear and convincing evidence. There is no room for speculation, inference or surmise and obviously, any doubt must be resolved against the charging party.

Smith International, Inc. v. Olin Corp, 209 USPQ 1033, 1043-44 (TTAB 1981), citations omitted. See also First International Services Corp. v. Chuckles, Inc., 5 USPQ2d 1628 (TTAB 1986).

Considering first the statements made by respondent in the Statement of Use, and the subsequent amendment, with respect to the scope of the goods on which the mark had been used, we find the evidence of record convincing that this overly broad identification of goods was the result of an honest misunderstanding or mistake on the part of Laurie Cybul. Having been advised, and correctly so, that the original intent-to-use application could be filed with a broad identification of goods, Ms. Cybul apparently signed the Statement of Use with the same understanding. Even if this were not the case, the evidence is clear that upon receiving the registration certificate and viewing the broad scope of goods covered thereby, Ms. Cybul immediately took steps to correct this mistake. Regardless of the motivating factors for this action, Ms. Cybul filed a Request for Correction within a short time after the registration issued, limiting the goods to the two products upon which she believed she had used the mark. By this action, respondent fulfilled its duty to correct the false statement as to the scope of the goods upon which the mark was honestly believed to have been used as of the filing of the Statement of Use. See Mister Leonard Inc. v. Jacques Leonard Couture Inc., 23 USPQ2d 1064 (TTAB 1992)(applicant is under a duty to

correct material, false statements made to the PTO when their falsity becomes known).

Turning to the question of material, false statements with respect to the dates of use, we note that while the February 11, 1998 date claimed for the sale of soap was set forth in the Statement of Use and the registration as it initially issued, it was the August 10, 1997 date claimed for the sale of perfume which was ultimately set forth in the certificate of correction issued for the registration.
Respondent is thus relying upon, and in fact strenuously advancing, the date of its proffering of the perfume at its booth at the New York International Gift Fair as the first use in commerce date.

Under Section 45 of the Trademark Act, use in commerce requires that the goods upon which the mark is placed be "sold or transported in commerce."[7] Respondent has acknowledged that although the Cybuls worked hard to promote their perfume at the show, there were no orders

[7] The definition of "use in commerce" reads:

> For purposes of this Act, a mark shall be deemed to be in use in commerce –
>
> (1) on goods when-
>
> (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto,... and
>
> (B) the goods are sold or transported in

taken or any sales made, either at the show or on follow-up. Thus, there was no use in commerce as defined by the Trademark Act.

We are convinced, however, that even though respondent's reliance upon this date was erroneous, respondent had a reasonable basis for believing that this was an appropriate date for purposes of first use. Clearly there was a significant exposure of the goods bearing the mark to the public. Despite its failure to make any sales, respondent had good reason to believe that that the goods had been presented to a large number of persons by their display at this well-attended trade show. Thus, we find no willful intent on the part of respondent to deceive the Office by relying upon this date as one of first use in commerce. Although under the statute, the statement in the Statement of Use was incorrect in setting this date forth as a date of first use, we believe the statement was in fact made by respondent with a reasonable and honest belief that it was true. Petitioner's charge of fraud with respect to respondent's reliance upon this date will not lie.

The only other date which respondent has relied upon is the February 11, 1998 date of the alleged sale of soap

---

commerce.

to David Trugerman. Here we have the conflicting testimony of Laurie Cybul of the sale of three bars of soap to Mr. Trugerman for $5.50 and the testimony of Mr. Trugerman that, although receiving the soap, he never paid for the same. Respondent has proffered no evidence by which we might determine that a sale actually took place. Furthermore, even if Mr. Trugerman received the soap, he discarded the same and thus there unquestionably was no exposure of the soap to any of his customers or other members of the public. While once again we do not consider respondent's reliance upon this date to rise to the level of willful intent to deceive the Office or to fall within the confines of fraud, it is true that the statement of first use as of this date is not substantiated by the record.

Thus, petitioner has failed to establish by clear and convincing evidence its claim of fraud. Nonetheless, we find that a lesser claim of nonuse of the mark by respondent as of either the filing of the Statement of Use or the issuance of the registration will lie. In the petition to cancel, petitioner alleges the following:

> 18. Upon information and belief, Registrant as of November 1998 (the month following the issuance of the Registration) had made no use of the purported mark BIRTHSTONE on any of the goods... identified in the Statement of Use.

We have found that respondent is not entitled to rely upon either the August 10, 1997 or the February 11, 1998 date as a date of first use in commerce as defined in the Trademark Act. Respondent has made no evidence of record of any other use of its mark in connection with perfume and/or soap prior to the October 20, 1998 issuance date of the registration. Thus, the registration is void on the basis of nonuse of the mark not only prior to the filing of the Statement of Use but even prior to the issuance of the registration.[8] The petition for cancellation is granted on this ground.

Although we have granted the petition to cancel on the basis of nonuse of the mark, for the sake of completeness, we have also considered petitioner's claims of genericness and mere descriptiveness of applicant's BIRTHSTONE mark.

In its claim of genericness, petitioner argues that the term "birthstone" is used in a generic sense when used to identify products containing birthstones or faux

[8] Respondent is restricted with respect to any potential amendment of its dates of use by Trademark Rule 2.71 (c)(2) which provides :

> In a application under section 1(b) of the Act, after filing a statement of use under §2.88, the applicant may not amend the statement of use to specify a date of use that is subsequent to the expiration of the deadline for filing the statement of use.

birthstones and that the buyers would so understand the term. Petitioner has made of record dictionary definitions of the term "birthstone"; information published by jewelers and trade associations identifying the various birthstones for the months of the year; and evidence of the use and sale by third parties of various products containing either birthstones or faux birthstones which are referred to as "birthstone" products.

The critical issue in determining genericness is whether members of the relevant public primarily use or understand the designation sought to be registered as reference to the genus or category of goods in question. See H. Marvin Ginn Corp. v. International Association of Fire Cheifs, Inc., 792 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). In making our determination, we follow the two-step inquiry set forth in *Marvin Ginn* and recently reaffirmed in In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), namely:

(1) What is the genus or category of goods at issue?, and

(2) Is the designation sought to be registered understood by the relevant public primarily to refer to that genus or category of goods?

Here the goods at issue are perfume and toilet soap. By dictionary definition, the term "birthstone" is used in a generic sense to identify "a precious stone considered as appropriate to or symbolizing the influences due to the month of one's birth." (Pet. Exhibit 15). It is the gem or stone itself which the relevant public would understand the term "birthstone" to refer to and not the name for any particular product containing such a stone. Whether or not respondent's perfumes and soaps contain or are packaged together with a birthstone or faux birthstone, the genus of respondent's products remains perfumes and soaps. BIRTHSTONE is not generic for respondent's products.

When we turn to the issue of mere descriptiveness, however, the test is a much different one. A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods with which it is being used. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term is merely descriptive is determined not in the abstract, but rather in relation to the goods for which registration is sought, the context in which the designation is being used, and the significance the

designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). It is not necessary that the term describe all the characteristics or features of the goods in order to be merely descriptive; it is sufficient if the term describes one significant attribute thereof. See In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

Petitioner contends that the term BIRTHSTONE as used by respondent in connection with its perfume and soap products immediately conveys information to consumers with respect to a significant feature or characteristic of respondent's goods, namely, the incorporation of faux birthstones therein and/or the design of the products to actually resemble birthstones.

In support of its argument of the descriptiveness of the term, petitioner relies upon the evidence of record of the descriptive reference by both petitioner and others to products incorporating jewels, or representations of jewels, identifying the various months of the year as "birthstone" products. In particular, petitioner has introduced Avon catalogs offering not only various types of birthstone or simulated birthstone

jewelry, such as birthstone necklaces, birthstone pins and birthstone pendants, but also other items such as birthstone clocks, birthstone flower magnets (combining a different flower with a simulated birthstone for each month), birthstone angel ornaments, birthstone pens and the like. (Trepano deposition). In addition, petitioner has introduced evidence of third-party use and sale of goods containing birthstones, or in most instances faux or simulated birthstones, with which the term "birthstone" is used in a descriptive sense. Not only do we find evidence of the commonplace use of "birthstone" in connection with jewelry items, but also examples of use of the term in connection with items such as a "birthstone angel ornament" (Pet. Ex. 20) or an "angel birthstone figurine." (Pet. Ex. 18).

While respondent's goods are identified in the registration as perfumes and toilet soaps with no specific limitations, as marketed respondent's goods are perfumes sold in bottles containing simulated birthstones in the caps thereof and soaps which have an acrylic gem simulating a birthstone embedded in the soap, with the soap being two-tone colored to coordinate with the acrylic gem. Although respondent argues that one of its perfume products, the splash perfume, does not contain an

imitation or acrylic gem birthstone, the inclusion of a simulated or faux birthstone is a significant feature of a majority of the goods. Furthermore, it is well settled that registration is properly refused if the proposed mark is merely descriptive of any of the goods for which registration is sought. See In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988) and the cases cited therein.

We find the evidence as a whole demonstrates that the consuming public is well accustomed to the association by the manufacturers and sellers of goods containing birthstones, or in most cases imitation birthstones because of the cost of the actual gems, with the term "birthstone" in a descriptive sense.[9] We see no reason why any distinction should be made in the case of respondent's perfumes and soaps, which similarly include a "birthstone" acrylic gem as an integral feature of the goods. The "birthstone," albeit only an acrylic "gem," is embedded in respondent's soaps and the soaps are color coordinated to match the gem.[10] In the case of the

[9] Although respondent points to examples in which petitioner appears to have used the term "birthstone" in a trademark sense in connection with its cologne product, petitioner's arguments here clearly act as an estoppel to any non-descriptive significance which it may have at one time attributed to the term.

[10] The color coordination serves simply as a reinforcement of the birthstone embedded in the soap and is not, as the dissent

perfume, the birthstone is embedded in the cap of the bottle containing the perfume. These products are also being offered to the public as goods incorporating representations of the various birthstones; these, too, are "birthstone" products. The attraction to the public is the same whether the product is a birthstone magnet or a birthstone soap. Both are selected because of the presence of the birthstone in the goods, even though it may be a inexpensive simulation of the actual gem, and the birthstone's identification of a particular birth month. Contrary to the view expressed in the dissent, we do not find the birthstone to be merely a decoration on the packaging of the goods, but rather a significant feature and part of the goods themselves upon which the decision to purchase the goods may be based.

Thus, the consuming public, upon encountering the term BIRTHSTONE being used in connection with perfumes and toilet soaps which contain simulated birthstones would immediately make the association between the term BIRTHSTONE and this significant feature of the goods. Accordingly, we find respondent's proposed mark BIRTHSTONE merely descriptive as used in connection with the recited perfumes and toilet soaps.

---

appears to infer, the feature upon which we are relying to hold

Decision: The petition to cancel is granted and the registration is held void on the ground of nonuse of the mark prior to the filing of the Statement of Use or the issuance of the registration. The petition is also granted on the ground that the term BIRTHSTONE is merely descriptive under Section 2(e)(1).

Drost, Administrative Trademark Judge, concurring-in-part and dissenting-in-part

I concur with the majority's holding that respondent's application is void because of nonuse of the mark. I also agree that respondent's mark is not generic. However, I dissent from the holding that respondent's mark is merely descriptive. I do this because the term BIRTHSTONE does not describe a feature, characteristic, or ingredient of respondent's perfume or soap. A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics *of the goods or services* or if it conveys information regarding a function, purpose, or use *of the goods or services*. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also 2 McCarthy on Trademarks and Unfair Competition, § 11.16 (4th ed.) ("A

BIRTHSTONE merely descriptive.

mark is 'descriptive' if it is descriptive of the intended purpose, function or use *of the goods*, the size *of the goods*, the class of users *of the goods*, a desirable characteristic *of the goods*, or the end effect upon the user") (emphasis added).

As part of its marketing of its products, applicant includes or intends to include a birthstone of no intrinsic value on the containers or packaging for its perfumes and soaps. Nothing in the record indicates that the birthstone is part of the goods themselves. For the perfume, the birthstone is contained in the cap for the perfume. For the soap, the birthstone appears to be used to hold the wrapping for the soap together. I assume that the stone is removed when the soap is used and not part of the soap itself because a bar of soap with a large, hard object attached to it seems impractical at best, and painful at worst. Also, while respondent's goods may be color coordinated with the color of various birthstones, it does not mean that the term "birthstone" immediately describes a quality, characteristic, or ingredient of the product. It would take some thought to understand that the term "birthstone" describes a soap that is the color coordinated with the colors associated

with diamonds, amethysts, peridots, and other stones. Petitioner's Second Notice of Reliance, Ex. 14, p. 3.

The only immediate connection between the term BIRTHSTONE and the goods is that packaging or containers of the goods may have a birthstone on it. A term is not descriptive if it only describes the packaging or marketing of the goods. There is no doubt that BIRTHSTONE is at least descriptive of various goods that contain birthstones such as rings, jewelry, refrigerator magnets, and figurines. Anyone who is making a product in which the birthstone is a significant feature of the goods should be free to describe their goods as "birthstone refrigerator magnets" or "birthstone angel figurines." However, a mark does not become descriptive because the trademark owner chooses to include a three-dimensional representation of its mark along with its goods. For example, the term "apple pie" would be generic for pies containing apples and descriptive of potpourri that simulated the smell of apple pie. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). However, it would not be descriptive of DESSERT brand computers that were packaged in boxes that smelled like pies or that attached a three-dimensional, plastic representation of various desserts to the goods.

I note that the majority is not basing its decision on any finding that the term "birthstone" is descriptive of products marketed in a group that includes different designs for the twelve months of the year. If petitioner established that "birthstone" was a descriptive term for products marketed in this way, then it may be descriptive. However, the key to the holding of descriptiveness appears to be the fact that respondent includes an intrinsically valueless, three-dimensional representation of a birthstone with the packaging or containers for the goods. Because the picture or name of the birthstone is apparently not descriptive, the representation of the birthstone cannot also be descriptive. The Trademark Act sets out that: "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register *on account of its nature."* 15 U.S.C. § 1052 (emphasis added).

> It is hornbook law that a visual representation which constitutes merely an illustration of one's product is unregistrable under Section 2(e)(1) of the Trademark Act just as is a merely descriptive word…. The rule has also been applied to subject matter sought to be registered in respect of services where the pictorial representation is of an article which is an important feature or characteristic of the services. In re Eight Ball Inc., 217 USPQ 1183 (TTAB 1983)

> [Representation of a cue stick and ball held merely descriptive of billiard parlor and/or arcade services].

In re Underwater Connections, Inc., 221 USPQ 95, 95 (TTAB 1983) (Stylized drawing of compressed gas tank used in diving is merely descriptive of travel tour services involving underwater diving).

The reverse should also be true. When the term and a picture of the term are not descriptive, than a three-dimensional representation of the mark should not be descriptive either.

Because petitioner has not met its burden of showing that the term “birthstone” is merely descriptive for perfume and soap, it is not entitled to prevail on this point.